

## **REMARKS**

The Office Action dated August 23, 2006, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 6 and 7 were withdrawn pursuant to the Election of Species Requirement dated April 25, 2006. Accordingly, claims 1-5 are respectfully submitted for consideration.

### **Rejections Under 35 U.S.C. § 102 and § 103**

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Nakajima (U.S. Patent No. 6,452,775 B1), Krishnaraj et al. (U.S. Patent No. 6,175,485 B1, "Krishnaraj") or Collins et al. (U.S. Patent No. 5,350,479, "Collins"). Claims 2 and 3 depend from claim 1. The Office Action took the position that Nakajima, Krishnaraj and Collins disclose the claimed features of the invention and that the claimed ratio of oxygen to metal is inherent in the prior art references. See page 3, lines 3-6 of the Office Action. The Applicants respectfully submit that Nakajima, Krishnaraj and Collins fail to disclose or suggest the claimed features of the invention.

Claims 1, 2 and 4 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Amano et al. (U.S. Patent No. 4,774,150, "Amano"), Hasz et al. (U.S. Patent No. 5,773,141, "Hasz") or Yasuda et al. (U.S. Patent No. 5,955,182, "Yasuda"). Claims 2 and 4 depend from claim 1.

Claims 1, 2 and 5 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Amano, Sahoo et al. (U.S.

Patent No. 5,993,976, "Sahoo") or Goedjen et al. (U.S. Patent No. 6,306,515 B1, "Goedjen"). Claims 2 and 5 depend from claim 1.

As a preliminary matter, the Applicants note that Amano was previously cited on page 3, paragraph 7 of the Office Action in the rejection of claims 1 and 2. As such, the repeated rejection of claims 1 and 2 in view of Amano appears to be in error.

Claim 1 recites a sprayed coating formed by plasma spraying inside a semiconductor processing device, the coating comprising a metal oxide composed of oxygen and a metal, or a semiconductor oxide composed of oxygen and a semiconductor. A composition ratio of the oxygen with respect to the metal or the semiconductor is not less than 80% of a composition ratio of the stoichiometric composition.

The Applicants respectfully submit that there is no disclosure or suggestion in the references of a composition ratio of the oxygen with respect to the metal or the semiconductor being not less than 80% of a composition ratio of the stoichiometric composition. Specifically, claim 1 recites not only a composition ratio of oxygen to metal, but also the composition ratio of oxygen with respect to the metal or semiconductor in relation to a composition ratio of the stoichiometric composition. None of the cited references disclose or suggest the claimed relationship between a composition ratio of oxygen with respect to the metal or semiconductor and a composition ratio of the stoichiometric composition. Specifically, the cited references do not disclose or suggest the composition ratio of the oxygen with respect to the metal or semiconductor being not less than 80% of a composition ratio of the stoichiometric composition, as recited in claim 1. Although the Office Action took the position that the

ratio of oxygen to metal is inherent, the Applicants note that the references do not disclose or suggest the comparison of the two different ratios in the claimed percentage.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . . [t]he identical invention must be shown in as complete detail as is contained in the patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicants respectfully submit that the cited references do not disclose or suggest the composition ratio of the oxygen with respect to the metal or the semiconductor is not less than 80% of a composition ratio of the stoichiometric composition as recited in claim 1. Accordingly, the cited references do not anticipate claim 1, nor is claim 1 obvious in view of the cited references. As such, the Applicants submit that claim 1 is allowable over the cited art.

Claims 2-5 depend from claim 1 and are allowable for at least the same reasons.

#### Double Patenting

Claims 1, 2 and 4 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 7 and 8 of co-pending Application No. 10/737,816 to Miyaji et al. (“the ‘816 application”). The Office Action took the position that although the conflicting claims are not identical, they

are not patentably distinct from each other because the pending claims fully encompass the claims of the co-pending application.

The Applicants respectfully traverse the rejection. However, in order to expedite prosecution and place the application in condition for allowance, the Applicants submit herewith the attached Terminal Disclaimer executed by the Applicants' representative.

The Applicants submit that the Terminal Disclaimer is in compliance with 37 C.F.R. § 1.321(c) and overcomes the statutory obviousness-type double patenting rejection of claims 1, 2 and 4. The Applicants also submit that claims 1, 2 and 4 recite subject matter that is neither disclosed nor suggested by the cited prior art, and therefore, renders the claims nonobvious to a person of ordinary skill in the art. Accordingly, the Applicants respectfully request that the double patenting rejection be withdrawn.

### **Conclusion**

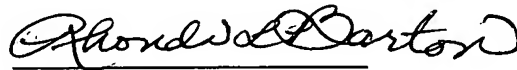
The Applicants respectfully submit that claim 1 is allowable. Claims 2-5 depend from claim 1. The Applicants further submit that each of these claims incorporate the patentable aspects thereof, and are therefore allowable for at least the same reasons as discussed above. Accordingly, the Applicants respectfully request withdrawal of the rejections, allowance of claims 1-5 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an

extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 108421-00087.**

Respectfully submitted,



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Enclosure: Terminal Disclaimer for U.S. Patent Application No. 10/737,816

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